

59. (Amended) A method of curling and/or thickening keratin fibers comprising applying to said keratin fibers an effective amount for said curling and/or thickening of a mascara composition comprising:

- (i) a wax-in-water emulsion of at least one wax having a needle penetration ranging from 1 to 7.5 and a melting point ranging from 70°C to 110°C, wherein said at least one wax is present in an amount of greater than 9% by weight relative to the total weight of said composition, and further wherein said at least one wax is in the form of particles greater than or equal to at least 1 µm in size and

- (ii) at least 0.1% by weight, relative to the total weight of said composition, of a polymer system containing at least one film-forming polymer, wherein said polymer system is capable of forming a film which produces, at a concentration of 7% in water, a greater than 1% retraction of isolated stratum corneum at 30°C and under a relative humidity of 40%,

wherein said at least one wax comprises both a rice bran wax and a polyethylene wax.

### **REMARKS**

#### **I. Claim amendments and status**

Claims 1-32 and 59 are pending and all claims stand rejected. Claim 59 has been amended to replace "at least 9%" with --greater than 9%-- to render this claim consistent with the other pending independent claims, in particular claim 1. Support for this amendment can be generally found in the present specification. For example, the present application describes a prior art composition comprising carnuba wax (9%), beeswax (11.1%), and hydroxycellulose (1.5% and a film former). While carnuba wax is

included within the "at least one wax" as recited in claim 1, beeswax, being too soft and melting at too low of a temperature, is not. See the present application at page 12, line 15-page 13, line 4. Thus, there is only 9%, *i.e.*, the amount of carnuba wax, of the "at least one wax" as listed in this composition.

The present application further states that the "at least one wax" being present in an amount of 9% is "outside the invention." See the present application in the upper right hand corner of the table on page 24. Reading the passages stating the "at least one wax" being present in an amount of 9% is "outside the invention" and the "at least one wax" may be present without limitations being placed on its amount, as generally described in the present specification, reasonably would have conveyed to persons of ordinary skill in the art that the present inventors (Bertrand Piot *et al.*) invented the claimed method reciting a composition comprising "at least one wax . . . present in an amount of greater than 9%" as recited in amended claims 1 and 59. Accordingly, new matter has not been added.

Claim 59 has also been amended to recite that the "at least one wax comprises both a rice bran wax and a polyethylene wax." Support for this amendment can be found in Applicants' specification as originally filed, in particular at page 5, lines 10-12. No new matter has been added.

**II. This Office action should not be final.**

The Examiner indicated in the Office Action of June 6, 2002, page 1, that the rejection made therein is "final." We respectfully traverse the finality of the rejection and ask that it be withdrawn.

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A second Office action may be made final unless the examiner introduces a new ground for rejection that is neither necessitated by applicant's amendment nor based on a document submitted in an IDS after a first action. See *M.P.E.P.*

§ 706.07(a). In this application, the anticipation rejection (§ 102) over Arraudeau (U.S. Patent No. 5,154,916) was included for the first time in the most recent Office Action. Arraudeau was not cited on the IDS which was filed after the first action. Additionally, Arraudeau could have been cited against the claims as originally filed. Therefore, the ground for rejection was not necessitated by Applicants' amendment in response to the first Office Action. Accordingly, the finality of the outstanding Office Action is incorrect and we respectfully request that it be withdrawn.

### **III. Nonstatutory Double Patenting Rejection**

Claims 1-32 and claim 59 stand rejected over the parent patent (U.S. Patent No. 6,274,131 B1) under the judicially created doctrine of obviousness-type double patenting. Applicants propose to file a terminal disclaimer to overcome the instant rejection. However, at this time Applicants respectfully request that the rejection be held in abeyance until the Examiner indicates that the instant claims are otherwise allowable.

### **IV. Rejection under 35 U.S.C. § 112, First Paragraph**

Claims 1-32 and claim 59 stand rejected under 35 U.S.C. § 112, first paragraph. Specifically, the Examiner has stated that "there is no affirmative disclosure to support the weight range of the 'at least one wax' between greater than 9 and less than 10 percent by weight of the total composition." We respectfully traverse this rejection with

respect to all claims on the basis that the Examiner has failed to provide a prima facie showing of a lack of written description for this limitation.

Under the current law, written description support for numerical ranges in claims need not correspond exactly to the words contained in the specification. See, e.g., *Vas-Cath, Inc. v. Mahurkar*, 19 USPQ2d 1111 (Fed. Cir. 1991). The legal test for satisfying the written description requirement is whether one of ordinary skill in the art could derive the claimed ranges from the application's disclosure. *Id.* Moreover, the analysis must take into account which ranges one of ordinary skill in the art would consider inherently supported by the discussion in the original disclosure. *In re Wertheim*, 191 USPQ 90, 97-98 (CCPA 1976); *M.P.E.P.* § 2163.05 III. For example, in *Wertheim*, even though the specification disclosed "25%-60%," a limitation to "between 35% and 60%" was held to satisfy the written description requirement, because the specification also disclosed an example containing 36%. *Id.* at 98.

In the instant case, the specification contains passages that would have guided one of ordinary skill in the art to the "greater than 9%" range recited in the claims. First, the recited amount of wax is described as "preferred" in the description:

"Advantageously, the composition according to the invention can comprise an amount of the mixture of waxes (I) preferably ranging from 10% to 30% by weight...." See *id.*, p. 5, ll. 13-14. Just like the disclosure of 36% in *Wertheim* inherently supported a lower limit of 35%, the disclosure of 10% here should reasonably support a limitation of greater than 9% in the present claims.

Second, the present application teaches that the "at least one wax" present at 9% is "outside the invention." See Example 9 at pp 24-25. If 9% is outside the

invention, then greater than 9% must be inherently supported. One of ordinary skill in the art would have been able to derive the "greater than 9%" range of claim 1 from the disclosure that the wax cannot be present at 9% by weight, relative to the total weight of the composition. Therefore, the specification of the present application provides sufficient written description support for the "greater than 9%" by weight limitation to satisfy the requirements of 35 U.S.C. § 112, first paragraph. Accordingly, Applicants respectfully request that the rejection be withdrawn with respect to all claims.

**IV. Rejection under 35 U.S.C. § 112, Second Paragraph**

Claim 59 stands rejected as indefinite. See Office action, para. 2. According to the Examiner, the phrase "at least one wax comprises a rice bran wax and a polyethylene wax" is vague and indefinite since it is unclear if both waxes must be present to satisfy the claim limitation. Applicants have amended claim 59 to recite that the at least one wax comprises both a rice bran wax and a polyethylene wax. Accordingly, Applicants respectfully submit that the rejection of claim 59 under 35 U.S.C. § 112, second paragraph, is overcome and ask that it be withdrawn.

**V. Rejection Under 35 U.S.C. § 102**

Claims 1-4, 7-9, 18-22, 24-29, and 32 stand rejected as anticipated by Arraudeau (U.S. Patent No. 5,154,916), see Office action, pp. 3-4. Applicants respectfully traverse this rejection with respect to all claims on the basis that Arraudeau does not disclose all of the instant claim limitations, either explicitly or inherently.

In order to find that a reference is anticipatory under Section 102(b), the Examiner must show that **all** limitations of the claims at issue are described in a single reference, either explicitly or inherently. M.P.E.P. § 2131.

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In the Office Action, the Examiner cites Arraudeau's example 4, noting that it includes carnauba wax and beeswax in the ratio of 3.3:1, as well as keratin hydrolysate and tragacanth gum. In order to properly anticipate the instant claims, Arraudeau must, among other things, disclose either explicitly or inherently that the compositions described contain waxes with a particle size greater than or equal to 1  $\mu\text{m}$ . This Arraudeau does not do. In fact, nowhere in the Arraudeau reference is the particle size of the waxes even mentioned or discussed. Therefore, the Arraudeau reference does not disclose all the limitations of the instant claims and does not anticipate them under 35 U.S.C. § 102(b).

In order to make up for this deficiency in the Arraudeau reference, the Examiner relies on a "presumption" that the disclosed compositions contain waxes with a particle size of greater than or equal to 1  $\mu\text{m}$ . Applicants respectfully contend that relying upon such a presumption is improper in support of a rejection under Section 102(b). Rather, the Examiner must point to specific information contained in the Arraudeau reference showing that the wax particles in the disclosed compositions are of the required size. The Examiner has failed to make the required showing. Therefore, a rejection of the instant claims under 35 U.S.C. § 102(b) in view of Arraudeau is improper. Applicants respectfully request that it be withdrawn with respect to all claims.

## **VII. Conclusion**

In view of the foregoing amendments and remarks, Applicants respectfully request the reconsideration and reexamination of this application and the timely allowance of the pending claims.

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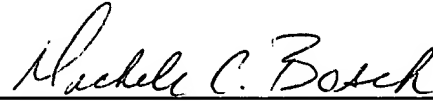
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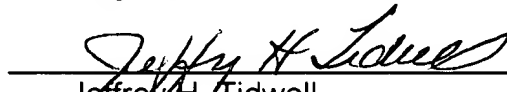
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Dated: December 6, 2002

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**APPENDIX - Version with Markings Showing the Changes Made by the  
Amendment of December 6, 2002**

The Appendix displays the changes in the traditional, but abandoned, format.

59. (Amended) A method of curling and/or thickening keratin fibers comprising applying to said keratin fibers an effective amount for said curling and/or thickening of a mascara composition comprising:

- (i) a wax-in-water emulsion of at least one wax having a needle penetration ranging from 1 to 7.5 and a melting point ranging from 70°C to 110°C, wherein said at least one wax is present in an amount of [at least] greater than 9% by weight relative to the total weight of said composition, and further wherein said at least one wax is in the form of particles greater than or equal to at least 1 µm in size and

- (ii) at least 0.1% by weight, relative to the total weight of said composition, of a polymer system containing at least one film-forming polymer, wherein said polymer system is capable of forming a film which produces, at a concentration of 7% in water, a greater than 1% retraction of isolated stratum corneum at 30°C and under a relative humidity of 40%,

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